

REMARKS

Claims 1, 3 through 10, 12 through 28, 34 through 41, 43, and 44 through 49 are pending in this Application, in which claims 2, 11, 29 through 33, and 42 were previously canceled without prejudice or disclaimer and claims 17 through 40, 43, and 44 stand withdrawn from consideration pursuant to the provisions of 35 U.S.C. §121. Claims 1, 3 through 5, 8 through 10, 12 through 14, 16, and 41 are currently amended, and new claims 45 through 49 are currently added. Adequate descriptive support for the present amendment should be apparent throughout the originally filed disclosure as, for example, Abstract, ¶¶ [0010]-[0012], [0041], [0047], [0050], and [0052] of the corresponding US Pub. No. 20070226749. Applicants submit that the present amendment does not generate any new matter issue.

Telephonic Interview of September 21, 2010.

Applicants express appreciation for the Examiner's courtesy in granting and conducting a telephonic interview on September 21, 2010 at which time the subject invention was explained in light of Applicants' disclosure, the outstanding issues were discussed, and arguments substantially as hereinafter developed were presented. During the interview, Applicants' representative discussed certain features of claims 1 and 8. No formal agreement was reached, pending the Examiner's detailed reconsideration of the application upon formal submission of a response to the outstanding Official Action.

Election/Restriction

Applicants respectfully submit that the Examiner's requirement to cancel the withdrawn claims or take other appropriate action under 37 C.F.R. §1.144 (page 8, last paragraph of the

Office Action) is improper. Such a requirement is proper only when the application is in condition for allowance except for the presence of claims directed to an invention non-elected with traverse. Since there was no indication that the application is in condition for allowance, Applicants defer taking the required action at this stage, and retain the right to rejoin the non-elected species.

Claims 1, 3 through 10, 12 through 16, and 41 were rejected as obvious under 35 U.S.C. §103(a) based on *Rao et al.* (US 6,978,453, “*Rao*”) and *SyncML Meta-Information DTD* (“*DTD*”) in view of *Szeto* (US 7,188,143, “*Szeto*”).

In stating the rejection, the Examiner asserted that one having ordinary skill in the art would have been led to modify *Rao*’s firmware updating system by including *DTD*’s metadata indicating a content type, and *Szeto*’s unidentified supporting application, to provide a reliable system for a user to control and execute applications. Applicants respectfully traverse this rejection.

There are fundamental differences between the claimed inventions and the applied references that undermine the obviousness conclusion under 35 U.S.C. §103(a). Specifically, independent claims 1 and 41 recite, *inter alia*: “receiving **a command to execute on first data without providing identification information of any executable for the first data**; determining, from metadata of the first data, **a content type** of the first data; determining to identify an executable using the content type; and determining to operate on the first data using the identified executable.”

The above stressed features of the independent claims are neither disclosed nor suggested by any of *Rao*, *DTD*, or *Szeto*. In contrast, *Rao*'s command includes identification information of an **executable for updating firmware**.

Szeto is said to provide an unidentified executable, to determine content type from metadata of the first data, and to automatically identify an executable using the content type determined from the metadata.

However, as admitted by the Examiner (p. 4, last paragraph of the Office Action), *Szeto*'s **first command** specifies rendering the IM data (i.e., first data) with an **IM executable** identified from the IM message. Thereafter, when the IM executable realizes the IM data includes data that cannot be handled by itself (e.g., media player data), a **second command** specifies a **supporting executable** (i.e., media player) is called to render the media player data. Although the supporting executable is not unidentified in the first command, it is identified in the second command. In other word, *Szeto*'s **first command** specifies IM data and an **IM executable**, and *Szeto*'s **second command** specifies media data and a **media player executable**. *Szeto*'s commands simply do not exclude identification information of any executable for the first data. Therefore, *Szeto* fails to disclose or suggest "a command to execute on first data **without providing identification information of any executable for the first data**."

In addition, since *Rao*'s firmware updates occur behind the scene, and do not involve render any media content, *Rao*'s firmware update packages do not concern media content type that may be described as a "Type" element according DTD. The "Type" element (p. 11, 5.10, DTD) specifies the media type of the content information in a data element. *Rao*'s firmware update does not need to know media content type or use the content type information to determine an executable. Therefore, one skilled in the art would not be motivated to combine

the *Rao* and *DTD* as suggested by the Examiner. The combination appears to be based upon hindsight reasoning. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). "Not only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time--a technician without our knowledge of the solution." *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985).

Moreover, the asserted motivation to combine *Rao*, *DTD*, and *Szeto*: to provide a reliable system and method for IM users to execute and control applications in an IM environment according to *Szeto*, is logically irreverent to *Rao*'s firmware updates, let alone using SyncML DM to support firmware updates in *Rao*. Therefore, one skilled in the art would not be motivated to combine *Rao*, *DTD*, and *Szeto* in the manner suggested by the Examiner.

Claim 8, the patentability of which is separately advocated, recites "determining to **parse a content type of the first data based upon the node**, wherein the content type of the first data is stored at the electronic device according to the node." Although *Rao* uses a management tree to access and/or manipulate management objects which may be codes, data, or applications (col. 6, line 62 to col. 7, line 3), *Rao* merely uses the management tree and SyncML DM to support **firmware updates**, such as verifying and then storing a firmware update package, etc. (col. 5, line 65 to col. 6, line 4). *Rao* does not "parse a content type of the first data based upon the node" in the management tree and to identify an executable based upon the content type of the data. On the other hand, *Szeto* simply does not specify how the application type is determined (Step 1204 in FIG. 12A; col. 13, lines 2-10). As such, *Szeto* neither "parses a content type of

the first data based upon a node in a hierarchical nodular data structure stored at the electronic device.”

It is therefore apparent that even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite realistic motivation has been established, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir.1988). Applicants, therefore, submit that the imposed rejection of claims 1, 3 through 10, 12 through 16, and 41 under 35 U.S.C. §103(a) for obviousness based on *Rao* in view of *DTD* and *Szeto* is not factually or legally viable and, hence, solicit withdrawal thereof.

New claims 45 through 49.

New claims 45 through 48 depend from independent claim 1 and, hence, are free of the applied prior art for reasons advocated *supra* with respect to independent claim 1.

New independent claim 49 recites similar features to those in independent claim 1 and, hence, is free of the applied prior art for reasons advocated *supra* with respect to independent claim 1.

Accordingly, claims 45 through 49 are free of the applied prior art.

Therefore, the present application, as amended, overcomes the rejection of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

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Date

/Phouphanomketh Ditthavong/

Phouphanomketh Ditthavong
Attorney/Agent for Applicant(s)
Reg. No. 44658

Chih-Hsin Teng
Attorney/Agent for Applicant(s)
Reg. No. 63168

918 Prince Street
Alexandria, VA 22314
Tel. (703) 519-9951
Fax (703) 519-9958